

3-11-05

Fig. V

Appln. No.: 10/696,659
Notice Regarding Related Litigation

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0001-23
Intertrust Ref. No. IT-5.1.2.1 (US)

CERTIFICATE OF EXPRESS MAILING

hereby certify that this correspondence is being deposited with the United States Postal Service's "Express Mail Post Office to Addressee" service under 37 CFR § 1.10, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 9, 2005. Express Mail Label No.: EV 606104402 US

Signed: _____

Mary A. McCauley
Mary A. McCauley

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|------------------------------|---|-----------------------------|
| In re Application of: |) | |
| |) | |
| Karl L. GINTER et al. |) | Group Art Unit: 2132 |
| |) | |
| Application No.: 10/696,659 |) | Examiner: DARROW, Justin T. |
| |) | |
| Filed: October 28, 2003 |) | |
| |) | |
| For: SYSTEMS AND METHODS FOR |) | Confirmation No. 8787 |
| SECURE TRANSACTION |) | |
| MANAGEMENT AND |) | |
| ELECTRONIC RIGHTS |) | |
| PROTECTION |) | |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

NOTICE REGARDING RELATED LITIGATION

Applicants submit this Notice to inform the Examiner of the status of the litigation between InterTrust and Microsoft, captioned InterTrust Technology Corp. v. Microsoft Corp. (C 01-1640 SBA, N.D. Cal.), in fulfillment of their duty to disclose information potentially material to patentability under 37 C.F.R. §§ 1.56 and 1.97(b).

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicants submit this paper to bring to the attention of the Examiner the information herein. This paper is being filed, to the undersigned's knowledge, before the mailing date of a first Office Action on the merits for the above-referenced application.

The present application, Application No. 10/696,659, is a continuation of U.S. Application No. 10/106,742, which is a continuation of U.S. Application No. 09/327,405, which is a continuation of U.S. Application No. 08/760,440, which is a continuation of U.S. Application No. 08/388,107, which is an ancestor application of several patents asserted in the litigation.¹ These applications may also be related to patents in suit by 1) incorporating by reference one or more of the patents in suit and/or applications leading to the patents in suit; 2) containing statements that their subject matter may bear relation to the patents in suit and/or applications leading to the patents in suit; and/or 3) claiming the benefit of priority of common applications.

STATUS OF RELATED LITIGATION

This litigation has been dismissed with prejudice following settlement of the dispute. The history of the litigation is as follows. On April 26, 2001, InterTrust filed a Complaint alleging that Microsoft Corporation ("Microsoft") was infringing U.S. Patent No. 6,185,683 B1, assigned to InterTrust. See *InterTrust Tech. Corp. v. Microsoft Corp.*, (C 01-1640 SBA, N.D. Cal.). A copy of the Complaint is attached as Tab 1. On June 26, 2001 and July 25, 2001, InterTrust amended its complaint to add U.S. Patent Nos. 6,253,193 B1; 5,920,861; and 5,940,504.² See Tab 2.

¹ The following is a list of all patents asserted by InterTrust in the litigation: 6,389,402; 6,253,193; 6,185,683; 6,157,721; 6,112,181; 5,982,891; 5,949,876; 5,940,504; 5,920,861; 5,917,912; 5,915,019; and 5,892,900.

² The '504 patent was subsequently dismissed from this suit.

On August 29, 2001, Microsoft filed its Answer to InterTrust's Second Amended Complaint. See Tab 3. On September 17, 2001, Microsoft filed a First Amended Answer and Counterclaims, asserting twelve affirmative and other defenses, including, *inter alia*, noninfringement, invalidity, dedication to the public, prosecution history estoppel, and inequitable conduct, and counterclaiming for declaratory judgments of noninfringement and invalidity and unenforceability of the InterTrust patents, and for infringement of U.S. Patent Nos. 6,049,671 and 6,256,668 B1, allegedly assigned to Microsoft. See Tab 4, including Exhibit A³.

On October 26, 2001, InterTrust filed a Third Amended Complaint to add U.S. Patent Nos. 5,917,912; 5,892,900; and 5,982,891. See Tab 5. Microsoft filed its Answer and Counterclaims to InterTrust's Third Amended Complaint on November 8, 2001, see Tab 6, and filed an Amended Answer and a "Corrected" Amended Answer on November 14 and 15, respectively, see Tabs 7 and 8, asserting several additional affirmative defenses and counterclaims. See, e.g., *id.* at pages 9 and 13-20.

On February 6, 2002, InterTrust filed a second lawsuit against Microsoft, alleging infringement of U.S. Patent No. 6,157,721 ("the '721 patent"). See Tab 9.⁴ Microsoft filed its Answer and Counterclaims on March 25, 2002, and filed a First Amended Answer and Counterclaims on April 12, 2002, asserting thirteen affirmative and other defenses, including, *inter alia*, noninfringement, invalidity, dedication to the public,

³ To distinguish Exhibit A of Tab 4 from Exhibit A of Tabs 21, 22, 23, 31, and 32, Applicants hereinafter refer to Exhibit A of Tab 4 as Exhibit 4A.

⁴ This case was consolidated with case no. C 01-1640 SBA, filed April 26, 2001.

prosecution history estoppel, inequitable conduct, and unenforceability, and counterclaiming for declaratory judgment of noninfringement, invalidity and unenforceability. See Tab 10. On June 5, 2002, Microsoft served its Initial Disclosures Pursuant to Fed. R. Civ. P. 26(a)(1), identifying various technologies believed by Microsoft to bear on the validity of the '721 patent. See Tab 11.

On July 30, 2002, InterTrust filed a motion for leave to file a Fourth Amended Complaint, adding claims of infringement of additional InterTrust patents. This motion was granted on October 22, 2002. The Fourth Amended Complaint was filed on October 24, 2002, adding to the case claims of infringement of U.S. Patent Nos. 6,112,181; 5,915,019; 5,949,876; and 6,389,402 B1. See Tab 12.

On August 16, 2002, Microsoft served its Preliminary Invalidity Contentions Regarding U.S. Patent Nos. 6,253,193 B1 and 6,185,683 B1 ("Preliminary Invalidity Contentions"). See Tab 13. In its Preliminary Invalidity Contentions, Microsoft asserted that certain claims in those patents were indefinite, lacked enablement, and lacked an adequate written description. Microsoft also asserted that certain claims were anticipated or rendered obvious by various references. See *id.* at pages 3-7.

On October 24, 2002, InterTrust filed a Fourth Amended Complaint, adding to the case claims of infringement of U.S. Patent Nos. 6,112,181; 5,915,019; 5,949,876; and 6,389,402 B1. See Tab 14.

On November 1, 2002, Judge Sandra Brown Armstrong signed an Order granting, in part, Microsoft's Motion for a Partial Stay. See Tab 15. On November 5, 2002, Judge Armstrong signed a Further Case Management Order. See Tab 16. Both

orders listed the claims which were selected to be the subject of a “mini-Markman” and “indefiniteness” hearing. The case management order set out a timeline for the exchange and submission of Patent Local Rule (PLR) materials. The following chart lists the claims selected to be the subject of the PLR materials and the mini-Markman hearing.

| U. S. Patent Number | Claim(s) |
|----------------------------|-----------------|
| 6,253,193 B1 | 1, 11, 15, 19 |
| 6,157,721 | 1, 34 |
| 5,917,912 | 8, 35 |
| 5,920,861 | 58 |
| 5,982,891 | 1 |
| 6,185,683 B1 | 2 |
| 5,892,900 | 155 |

On November 7, 2002, Microsoft filed its Answer and Counterclaims to InterTrust’s Fourth Amended Complaint. See Tab 17.

On November 8, 2002, under PLR 4-1, the parties exchanged proposed terms and claim elements for construction. See Tabs 18 & 19.

On December 20, 2002, under PLR 4-2, the parties exchanged preliminary claim constructions and extrinsic evidence supporting the claim constructions. See Tabs 20 & 21. Microsoft’s PLR 4-2 Disclosure (Tab 21) includes Exhibits A-G⁵. Tab 21D contains

⁵ To distinguish Exhibits A-G of Tab 21 from Exhibits A-G of Tab 4, 22, 23, 31, and 32, Applicants hereinafter refer to Exhibits A-G of Tab 21 as Exhibits 21A-21G.

copies of excerpts from dictionaries and other publications. Due to the volume of the appended pages, Applicants have provided a list of the source dictionaries and publications in place of the excerpted pages. Tab 21F as submitted by Microsoft contains a list of selected, uncited prior art publications, identified by Bates numbers used by the parties in the litigation. For clarification, Applicants have added a list identifying each document in Tab 21F by name. Tab 21G as submitted by Microsoft contains a list of selected, uncited prior art patents, also identified by Bates numbers. For clarification, as above, Applicants have added a list identifying each of the listed documents by patent number. On January 10, 2003, Microsoft submitted revised Tab 21F and Tab 21G, in which the number of references was reduced. Applicants have identified the documents in the revised lists in bold.

On February 3, 2003, under PLR 4-3, the parties filed a Joint Claim Construction and Prehearing Statement. See Tab 22, including Exhibits A-G⁶. On March 14, 2003, the parties filed a revised Joint Claim Construction and Prehearing Statement, which includes Exhibits A-I⁷. See Tab 23.

On March 17, 2003, InterTrust filed InterTrust's Opening Claim Construction Brief. See Tab 24 (first page dated May 12, 29, & 30, 2003). On March 17, 2003, Microsoft filed Microsoft's Brief in Support of Motion for Summary Judgment that certain "Mini-Markman" Claims are Invalid for Indefiniteness. See Tab 25.

⁶ To distinguish Exhibits A-G of Tab 22 from Exhibits A-G of Tabs 4, 21, 23, 31, and 32, Applicants hereinafter refer to Exhibits A-G of Tab 22 as Exhibits 22A-22G.

⁷ To distinguish Exhibits A-I of Tab 23 from Exhibits A-G of Tabs 4, 21, 22, 31, and 32, Applicants hereinafter refer to Exhibits A-I of Tab 23 as Exhibits 23A-23I.

On April 7, 2003, InterTrust filed a Memorandum of Points and Authorities of Plaintiff InterTrust Technologies in Opposition to Microsoft Motion for Summary Judgment on Indefiniteness and in Support of Cross-Motion for Summary Judgment. See Tab 26 (first page dated May 30, 2003). Also on April 7, 2003, Microsoft filed its Markman Brief. See Tab 27.

On April 21, 2003, InterTrust filed its Reply Memorandum on Claim Construction. See Tab 28 (first page dated May 12, 29, & 30, 2003). On April 21, 2003, Microsoft filed a Reply to InterTrust's Opposition to Microsoft's Brief in Support of Motion for Summary Judgment That Certain "Mini-Markman" Claims are Invalid for Indefiniteness. See Tab 29.

On July 3, 2003, Judge Sandra Brown Armstrong issued an Order Denying Motion for Partial Summary Judgment and Construing "Mini-Markman" Claims. See Tab 30.

On September 2, 2003, InterTrust filed InterTrust's Disclosures of Asserted Claims and Preliminary Infringement Contentions Pursuant to Patent Local Rules 3-1 and 3-2. See Tab 31, including Exhibits A-C⁸. Exhibit 31C has not been provided because (1) it is marked "Confidential - Subject to Protective Order" and "Attorneys Eyes Only" (as it pertains to proprietary Microsoft information); and (2) it is not material to the patentability of the pending claims, as it contains only information pertaining to Microsoft's current products and systems.

⁸ To distinguish Exhibits A-C of Tab 31 from Exhibits A-C of Tabs 4, 21, 22, 23, and 32, Applicants hereinafter refer to Exhibits A-C of Tab 31 as Exhibits 31A-31C.

On November 17, 2003, Microsoft filed Defendant Microsoft Corporation's Preliminary Invalidity Contentions (Patent Local Rules 3-3 and 3-4). See Tab 32, including Exhibits A-C⁹.

On February 23, 2004, Microsoft filed a Notice of Motion and Memorandum in Support of Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '900 Patent (Anticipation). See Tab 33 (first page dated March 30, 2004). On February 23, 2004, Microsoft also filed a Notice of Motion, Motion and Memorandum in Support of its Motion for Partial Summary Judgment of Invalidity of the Asserted Claims of the '181 Patent (Anticipation). See Tab 34 (first page dated March 30, 2004).

The parties subsequently settled and, on May 5, 2004, filed a Joint Stipulation of Dismissal with Prejudice that was signed by Judge Armstrong on May 6, 2004. See Tab 35. A copy of the press release, dated April 12, 2004, announcing the settlement and indicating that Microsoft has taken a comprehensive license to InterTrust's patent portfolio for a one-time payment of \$440 million is provided. See Tab 36.

Remarks

Applicants encourage the Examiner to carefully review the attached documents, and let Applicants know if any additional information is desired.

With this Notice, Applicants have provided copies of the papers described in the Status of Related Litigation section above. Furthermore, a voluminous number of documents have been referred to in the Microsoft paper attached as Tab 32 (specifically

⁹ To distinguish Exhibits A-C of Tab 32 from Exhibits A-C of Tab 4, 21, 22, 23, and 31, Applicants hereinafter refer to Exhibits A-C of Tab 32 as Exhibits 32A-31C.

in Exhibit 32A, attached thereto). References listed in Exhibit 32A that might be potentially material to patentability are being submitted under 37 C.F.R. § 1.56 in an Information Disclosure Statement to be filed soon in this case. Furthermore, Exhibits 32B and 32C¹⁰ to Microsoft's Preliminary Invalidity Contentions, which comprise an extensive listing of claim charts pertaining to the patents-in-suit, are provided along with a summary of the claims addressed. This summary should help the Examiner determine which, if any, of the prior art claim charts of Exhibits 32B and 32C should be reviewed by the Office (for example, Exhibit 32C contains § 112 indefiniteness charts relating only to the claims of the patents-in-suit).

With this Notice, Applicants have provided copies of some of the exhibits referred to in the provided papers. However, due to the large quantity of documents referenced by these papers, all attachments and exhibits have not been provided. For example, the exhibits to the motions provided at Tabs 33 and 34 are not provided because they have inconsequential, if any, relation to the patentability of the instant claims. These exhibits are not necessary to understand the motion, and are not relevant to the Office's review (e.g., they are directed to issues specific to either the '900 or '181 patent, they pertain to Microsoft's products, they contain Microsoft's Attorneys-Eyes-Only information that we cannot disclose, etc.).

¹⁰ Exhibits 32B and 32C are provided in electronic format via CD-ROM due to their length.

As always, if the Examiner believes that any document referred to in these papers and not yet submitted may be helpful in resolving any issue before him and would like to review that or any other document, Applicants invite the Examiner to contact the undersigned at (650) 849-6643 so we may provide such document.


Applicants submit this Notice Regarding Related Litigation in fulfillment of their duty to disclose information potentially material to patentability under 37 C.F.R. § 1.56. This submission does not constitute an admission that any of the listed documents are material or constitute "prior art."

If there are any fees due with the filing of this Notice which have not yet been paid, please charge the fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 9, 2005

By: 
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